

(c) applying captured said transaction information to a second transaction involving said consumer at a second merchant not required to be associated with said first merchant.

#### REMARKS

Claims 1-8 were examined and finally rejected. The Examiner continued to object to the executed Declaration for not explicitly reciting that the within application was a continuation in part application. More specifically, claims 1-8 were rejected as being obvious and unpatentable under 35 USC §103 over USP 5,642,485 to Deaton, in view of USP 6,009,411 to Kepecs, and in view of USP 5,806,045 to Biorge.

Applicant has amended claim 1. Claims 1-8 are pending.

#### THE DECLARATION:

Applicant does not necessarily agree with the Examiner's continuing objection to the Declaration on file. However in the interest of concluding prosecution at this time, applicant submits a new Declaration herewith, demonstrating entitlement to the 9 May 1997 effective filing date of application serial no. 08/853,955.

#### AMENDED CLAIM 1 DOES NOT PRESENT NEW MATTER:

As noted in the Specification at page 8, line 25, the present invention can function with a user-presented card that identifies the user but lacks memory that is updated to record the subject transaction. Such cards typically include a magnetic stripe that identifies the user and user account number but lack memory that is updated to store information relating to a subject transaction. Examples of such cards are credit cards, debit cards, and loyalty cards. However excluded would be cards such as smart cards, which include updatable memory that is updated to record the subject transaction.

#### DEATON USP 6,642,485 AND KEPECS USP 6,009,411 DISTINGUISHED

Deaton '485 discloses a point-of-sale (POS) system, apparently for use by multiple customers, all within a single merchant store. Kepecs '411 is cited as disclosing a system enabling transaction customer data captured at a first merchant store to be used by a second merchant store when dealing with the very same customer. But it appears

from Kepecs that the second merchant store will always be affiliated or associated with the first merchant store. At col. 3, lines 2-27, Kepecs points out that stores, and "especially chains of retail stores" offer "loyalty cards which reward shoppers for frequenting the store(s) covered by the loyalty card". At the bottom of page 2 in the pending Office Action, the Examiner references col. 10, lines 5-19 "Customer\_No" as a disclosure by Kepecs of "identifying the consumer in a transaction at the second merchant".

But as noted above, the second merchant in Kepecs will be associated or affiliated with the first merchant, perhaps simply another branch in a chain of retail stores. Such associated or affiliated stores indeed share a common "loyalty card" among consumers, but store-issued such cards are not typically useable in a competitor's store. Thus, it is not disputed that neither Deaton '485 nor Kepecs '411 supports the concept of sharing information with a second merchant that is "not required to be associated with said first merchant", in contrast to claim 1.

However Biorge '045 is now cited as applying transaction data captured at a first merchant for use with a second merchant not necessarily associated with the first merchant. But to function as the Examiner asserts, Biorge '045 requires that the consumer present a somewhat complicated portable device that includes internal memory whose contents are updatable on a per transaction basis. More specifically, Biorge requires the consumer to carry a portable device 74, col. 2, lines 20-21, which device includes "a processor, a read-only memory (ROM) for storing a control program, and a non-volatile memory for storing and securing the customer-specific or provider-specific information", col. 2, lines 26-31. See also Biorge '045 Fig. 3 in which the customer device 74 includes these active elements. Note that Biorge claim 1, for example, explicitly requires that the customer-carried portable storage device have stored within an incentive credit total that is incremented by a relevant incentive credit amount. After the subject transaction, Biorge's customer-carried portable storage device will store new information reflecting the most recent transaction.

As such, Biorge '045 requires the customer to carry around a device or card that includes an internal memory that is updatable after each transaction to record the transaction. As such, the customer must carry around an artifact of the transaction. By contrast, in the presently claimed invention, it suffices for the customer or consumer to

present a card that contains no internal memory that can be updated following each transaction.

Applicant thus submits that while perhaps a combination of what is disclosed or suggested in Deaton '485 and/or Kepecs '411 and/or Biorge '045 might work with a smart card (e.g., a card or device with internal updatable memory that is updated on a per transaction basis), such combination will not work with a card that merely identifies the user but that carries no internal memory updated on a per transaction basis, as required by presently amended claim 1.

A marked-up version of the text showing additions and deletions is appended hereto with the caption "Version With Markings to Show Changes Made." Appearing thereafter is an "Appendix of Claims Pending After Current Amendment," so captioned.

#### CONCLUSION

Applicants submits that this Amendment should be entered and that claims 1-8 are allowable over the art of record, and should be passed to allowance at this time. A replacement Declaration is submitted herewith.

The Commissioner is authorized to charge any additional fees that may be required, including extension fees, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 467766-00109 [A-68146/MAK]).

Respectfully submitted,

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Filed under 37 C.F.R. § 1.34(a)

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[467766-00109]

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Claim 1 was amended as follows:

1. (further amended) A method for storing and retrieving consumer-transaction information, the method comprising the following steps:

(a) during a first transaction by a consumer at a first merchant, capturing transaction information regarding said transaction from a card presented by said consumer identifying said consumer but lacking memory updated to record said first transaction;

(b) storing captured said transaction information on a server; and

(c) applying captured said transaction information to a second transaction involving said consumer at a second merchant not required to be associated with said first merchant.

## **APPENDIX OF CLAIMS PENDING AFTER CURRENT AMENDMENT**

1. (further amended) A method for storing and retrieving consumer-transaction information, the method comprising the following steps:

(a) during a first transaction by a consumer at a first merchant, capturing transaction information regarding said transaction from a card presented by said consumer identifying said consumer but lacking memory updated to record said first transaction;

(b) storing captured said transaction information on a server; and

(c) applying captured said transaction information to a second transaction involving said consumer at a second merchant not required to be associated with said first merchant.

2. The method of claim 1, further including, prior to step (c) a step of identifying said consumer in a transaction at said second merchant.

3. The method of claim 1, further including prior to step (c) a step of communicatively coupling said first merchant, said second merchant, and said server via an internet.

4. The method of claim 1, wherein step (a) includes capturing consumer information at said first merchant.

5. The method of claim 1, wherein step (a) includes capturing consumer loyalty information at said first merchant.

6. The method of claim 1, wherein step (b) includes storing captured said transaction information on a server external to said first merchant.

7. The method of claim 1, wherein step (b) includes forwarding captured said transaction information to said server.

8. The method of claim 1, wherein step (c) includes applying captured said transaction information to a transaction involving said consumer at a second merchant and initiated by a browser on a personal computer connected to the internet.